

### **REMARKS**

The present application relates to hybrid maize plant and seed 39W54. Claims 5-8, 12, 20-21, 25, 33, and 41-58 have been canceled. Claims 9-11, 13-19, 22-24, 26-32, and 34-40 were previously canceled in the Amendment After Final submitted on May 12, 2003. Claims 1 and 2 have been amended. Claims 59-72 have been added at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. No new matter has been added by the present amendment. Applicant respectfully requests consideration of the following remarks.

#### **Detailed Action**

##### ***A. Status of the Application***

Applicant acknowledges the finality of the previous Office Action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicant further acknowledges that except for the remaining indefiniteness rejection against claims 8 and 21, the outstanding indefiniteness rejection, the new matter rejection, and the enablement rejection have been withdrawn.

#### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 8 and 21 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, as stated on page 2 in the Office Action mailed on February 11, 2003.

Applicant has canceled claims 8 and 21, thus alleviating this rejection.

Claim 58 stands rejected as indefinite for the recitation "no statistically significant variation from 39W54".

Applicant has now canceled claim 58, thereby alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

#### **Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 8, 12, 21, 25 and 43-58 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on page 5 in the Office Action mailed February 11, 2003.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 8, 12, 21, 25 and 43-58, thus alleviating this rejection. Applicant has added new claims 59-72 at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicant respectfully submits the claims now come within the purview of the written description requirement and request reconsideration.

Claims 8, 12, 21, 25 and 43-58 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention, as stated on page 5 in the Office Action mailed February 11, 2003.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 8, 12, 21, 25 and 43-58 thus alleviating this rejection. Applicant has added new claims 59-72 at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicant respectfully submits the claims now come within the purview of the enablement requirement and request reconsideration.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 8, 12, 21, 25 and 43-58 under 35 U.S.C. § 112, first paragraph.

### Summary

Applicant acknowledges that claims 1-7, 20, 33 and 41-42 are allowed.

Applicant further acknowledges that claims 1-10, 12-14, 16-18, 20-23, 25-27 and 29-31 are deemed free of the prior art. The Examiner further states the prior art fails to teach or fairly suggest the particularly claimed maize plants with their unique complement of genotypic and morphological characteristics, or methods of using them. This clearly indicates that hybrid maize plant 39W54 as a whole is considered to be distinguishable from the prior art for the purposes of novelty and non-obviousness. Therefore, Applicant respectfully submits that the

deposit of the representative seed of 39W54 and inbred parents (GE533274 x GE533275) and GE492318 should satisfy the description requirement. In light of the above, Applicant respectfully submits that the rejections under 35 U.S.C. § 112, first paragraph are improper and requests reconsideration and withdrawal of these rejections.

Applicant further acknowledges that claims 59-72 have been agreed upon as allowable by Supervisory Patent Examiner Amy Nelson as aforementioned, thereby placing these claims in form for allowance. Applicant has canceled all non-allowable claims thereby placing the application in condition for allowance and has complied with all requirements of form set forth in previous office actions.

### Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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